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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,886	09/04/2003	Kimmo Laakkonen	915-006.021	1554
4955	7590	05/01/2007	EXAMINER	
WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP BRADFORD GREEN, BUILDING 5 755 MAIN STREET, P O BOX 224 MONROE, CT 06468			WHIPPLE, BRIAN P	
		ART UNIT	PAPER NUMBER	
		2152		
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		05/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/656,886	LAAKKONEN, KIMMO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian P. Whipple	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 September 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-10 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-10 and 14-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 September 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date <u>2/11/05</u> .	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

1. Claims 1-2, 4-10, and 15-25 are pending in this application and presented for examination. Claims 3 and 11-13 were cancelled in a preliminary amendment received on 2/25/05. Claims 22-25 were added to the pending claims by the same preliminary amendment.
2. The preliminary amendment entered on 2/25/05 has been received and made of record.

#### ***Drawings***

3. The drawings are objected to because there is a lack of descriptive text legends for Fig. 1-5 [see 37 CFR 1.83, CFR 1.84 {5(e)}, MPEP § 608.02(e)].

#### ***Claim Objections***

4. As to claim 8, the claim refers to the method of claim 1, but is actually an independent claim for a software tool comprising program code means stored on a computer readable medium, and not a method. Claim 8 will henceforth be treated as an independent claim.
5. As to claims 9-10, the claims are objected to for the same reasons as claim 8 above. Claims 9-10 will henceforth be treated as independent claims.

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6. As to claim 21, the claim refers to the mobile terminal device of claim 14 and the push type e-mail server of claim 19, but is actually an independent claim for a push type e-mail delivery system. Claim 21 will henceforth be treated as an independent claim.

7. As to claims 22-24, the claims are objected to using similar rationale as to claim 8 above.

8. As to claim 25, the claim is objected to using similar rationale as to claim 21 above.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Program code downloadable from a server may be interpreted as software per se. Software fails to fall into one of the four statutory classes of invention: machine, manufacture, process, or composition of matter.

***Claim Rejections - 35 USC § 112***

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11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. As to claim 16, the phrase "said network terminal device" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-2, 4-10, and 14-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Theimer et al. (Theimer), U.S. Patent No. 5,493,692.

16. As to claim 1, Theimer discloses a method for controlling the handling of push type e-mails on a mobile terminal device (Abstract), said mobile terminal device comprising at least one user profile regarding the handling of push type e-mails (Abstract; Fig. 17, item 430; Col. 25, ln. 17-26), said method comprising:

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determining the status of said user profile (Col. 25, ln. 17-26), wherein said determined user profile status comprises push type e-mails enabled or push type e-mail disabled (Col. 25, ln. 46-51), and

controlling the handling of push type e-mails according to said determined user profile status (Col. 25, ln. 46-51).

17. As to claim 2, Theimer discloses said controlling of the handling of push type e-mails comprises notifying a push type e-mail server of a mobile communication network about the handling of push type e-mails according to said determined user profile (Fig. 1; Fig. 17; Col. 24, ln. 49-60).

18. As to claim 4, Theimer discloses said user profile comprises a predetermined filter acting on the received push type e-mails (Col. 25, ln. 23-26 and 52-57), said filter selecting push type e-mails according to properties of said received emails (Col. 25, ln. 23-26 and 52-57), wherein said method further comprises:

receiving a push type e-mail (Col. 25, ln. 6-12), and  
filtering said received e-mail according to said properties (Col. 25, ln. 23-26 and 46-57).

19. As to claim 5, Theimer discloses storing said received push type e-mail (Fig. 17, items 430, 432, and 436; Col. 25, ln. 46-51; it is inherent that if the application waits for

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a change in context before reattempting delivery that it must store the e-mail until the reattempt)

20. As to claim 6, Theimer discloses said terminal device further comprises sensors

(Fig. 1; Col. 12, In. 62-66), said method further comprising:

determining of sensor data (Fig. 1; Col. 12, In. 62-66), and

changing said user profile according to said determined sensor data (Fig. 1; Col. 9, In. 64 – Col. 10, In. 7; Col. 12, In. 62-66; Col. 25, In. 17-26).

21. As to claim 7, Theimer discloses a method for controlling the handling of push

type e-mails destined for mobile terminal devices on a push type e-mail server

(Abstract; Fig. 1; Fig. 17; Col. 24, In. 49-60), wherein said server stores at least one

user profile related to a mobile terminal device (Col. 25, In. 17-26), said user profile

regarding the handling of push type e-mails destined for said related mobile terminal

device (Col. 25, In. 23-26 and 46-57), said method comprising:

receiving at the push type e-mail server a notification from said terminal device  
related to the handling of push type e-mails destined for said terminal device via a  
mobile communication network (Fig. 1; Col. 10, In. 3-7; Col. 25, In. 17-26 and 55-57),  
wherein said received notification related to the status of said user profile comprises  
push type e-mail enabled or push type e-mail disabled (Col. 25, In. 46-57), and  
handling push type e-mails destined for said terminal device according to said  
received notification (Col. 25, In. 46-57).

22. As to claim 8, Theimer discloses a software tool comprising program code means stored on a computer readable medium for carrying out the method of claim 1 (Col. 8, ln. 52-58; see the rejection of claim 1 above), when said software tool is run on a computer or network device (Col. 8, ln. 52-58).

23. As to claims 9-10, the claims are rejected for the same reasons as claim 8 above.

24. As to claims 14-15, the claims are rejected for the same reasons as claim 1 above.

25. As to claim 16, the claim is rejected for the same reasons as claim 4 above.

26. As to claim 17, the claim is rejected for the same reasons as claim 2 above.

27. As to claim 18, the claim is rejected for the same reasons as claim 6 above.

28. As to claim 19, the claim is rejected for the same reasons as claims 1-2 above.

29. As to claim 20, Theimer discloses said e-mail server is an external mailbox capable of receiving push type e-mails (Col. 24, ln. 49-60; Col. 25, ln. 6-12 and 46-51).

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30. As to claim 21, the claim is rejected for the same reasons as claims 14 and 19

above.

31. As to claim 22, the claim is rejected for the same reasons as claims 7-8 above.

32. As to claims 23-24, the claims are rejected for the same reasons as claim 22

above.

33. As to claim 25, the claim is rejected for the same reasons as claims 15 and 20

above.

### ***Conclusion***

34. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. See the attached Notice of References Cited (PTO-892).

35. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Brian P. Whipple whose telephone number is (571) 270-

1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax

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phone number for the organization where this application or proceeding is assigned is  
571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPW

Brian P. Whipple

4/27/07



BUNJOB JAROENCHONWANIT  
SUPERVISORY PATENT EXAMINER